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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,953	07/26/2001	Aravinda Korala	0125US-KAL	8308
23521	7590	09/08/2004	EXAMINER	
SALTAMAR INNOVATIONS 30 FERN LANE SOUTH PORTLAND, ME 04106			CHRISTMAN, KATHLEEN M	
			ART UNIT	PAPER NUMBER
			3713	
DATE MAILED: 09/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,953

Applicant(s)

KORALA, ARAVINDA

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/06/2004 and 06/23/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 06 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

In response to the amendment filed 05/06/2004, and corrected 06/23/2004, claims 1-12 remain withdrawn from consideration; claims 13-20 are pending.

Drawings

1. The drawings were received on 05/06/2004. These drawings are accepted.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 13-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. The limitation "such that the user can be familiarized with and trained in proper use of said self-service kiosk", in **claim 13**, does not produce a concrete result. In order for a method to be concrete there must be a reasonable expectation of success, or the result must be assured. There is no reasonable expectation that a user, through using the online simulator will be trained in the proper use of the self service kiosk. Although it is likely that the user will be familiarized with the operation of the kiosk, there is no reasonable expectation that a user will be able to properly use the kiosk. Although the system may allow some user to learn the proper operating techniques of the kiosk, it is equally likely to not provide such training to a user. As there is no reasonable expectation of success, the result of the method is not assured.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** The preamble of claim 13 recites a method of training a user of a self-service kiosk however; the recited steps do not result in "training". The recited steps merely recite a method for providing a simulator of a self-service kiosk, intended to teach the user about the operation of the kiosk, at an address. There is no step in the method which actually shows how the method trains the user in the self-service kiosk.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 13-20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al (US 2003/0083943 A1).** As best understood and given the broadest reasonable interpretation of the claims the invention of Adams et al may be interpreted as the claimed "method of training a user of a self-service kiosk" as in claim 13. The step of "providing a self-service

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kiosk for providing one or more services to a user" is considered equivalent to Adams et al general teaching of providing an electronic game. The service being the playing of the game. Adams et al teaches providing electronic games online, which include demonstrations of the game so as to teach the user how to use the game in paragraph 20. This function is equated to the step of "providing at said address and online simulator simulating the function of said self-service kiosk such that the user can be familiarized with and trained in the proper use of said self service kiosk". The service requires the user to enter information or make selections relating to the service provided, as in **claim 14**, is taught by at least the user being required to input the amount of a wager (i.e. coins wagered) or select the option to spin, see the last two sentences of paragraph 16. The information being entered into a field, as in **claim 15** and similarly in the simulation of the machine as in claim 16, is shown in Figure 3 under the "coins" counter.

Adams et al does not specifically teach the step of "on or adjacent to the self-service kiosk, providing the address of an online simulator", as in **claim 13**. However, Adams et al does teach the advertisement's are placed around the housing of the game in paragraph 52. The examiner takes official notice that it is old and well known in the art to provide a web address in an advertisement. It would have been obvious to one of ordinary skill in the art to include the web address of the sponsoring company where the electronic versions of the game are located in the advertisements so as to attract players of the electronic game to the company web page. Regarding claims **17-19**, Adams et al does not specifically teach that the address of the "on-line training facility" (interpreted as the simulator) is provided by a removable printed document. The examiner takes official notice that removable advertisements such as business cards (**claim 18**) are old and well known in the art. It would have been obvious to one of ordinary skill in the art to provide the advertisements that include the online address in these forms so as to allow the user to conveniently recall or look up the address at a future time. Regarding **claim 20**, although Adams et al does not specifically state that the simulation also includes the simulation of peripherals other than a display this feature is clearly a matter of design choice. The actual components selected for a simulations display do not effect the overall function of the simulator only make it more

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attractive or realistic. As such it would have been obvious to one of ordinary skill in the art to visually simulate other peripherals (such as push buttons, a lever, etc.) in the on-line demonstration of the game.

Response to Arguments

4. Applicant's arguments filed 05/06/2004 have been fully considered but they are not persuasive.

Applicant firstly argues that the Adams et al reference is non-analogous art. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant states on page 1, lines 5 and 6, "The present invention related to the field of delivering web commerce through self-service kiosks". Further, on page 1, lines 14-16 of the originally filed specification it reads: "Self Service kiosks are networked computing devices designed for use by multiple users to carry out self-contained operations". Following this citation self examples are listed. These examples include a "public Internet Access portal". In paragraph 28 of Adams et al the gaming system is taught as public internet access portal. Further paragraph 40 teaches that the electronic game includes: "a microprocessor or other computer ... [which] may also be coupled to one or more other computers such as a central controller of a casino through a network card and link, modem and the like." This clearly teaches a networked computing device. Any electronic game of this sort is used by multiple users (i.e. the patrons of a casino) to carry out self-contained operations (wagering). A gaming terminal, such as the one described by Adams et al is clearly a "self-service kiosk" in term of the applicant's definition of such. Further, Adams et al clearly teaches that the Internet "demonstrations" are intended to teach a player about the intended games. The prior art defines a structure well within applicant's field of endeavor and as such is analogous art.

The applicant further argues that Adams fails to teach the step of providing a simulation (paragraphs 9-14 of the response). Stating that the user is Adams is clearly "playing

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the game" not a simulation of it. However, Adams et al teaches, "a player may access an electronic game such as a casino game through the Internet and use play money instead of real money", in paragraph 20. Thus the user enters the demonstration of the electronic game on-line, performs the functions as if it was the game itself, and is not actually awarded anything. Using the applicant's example of the self-service kiosk being an ATM. The user would enter the web page and find a simulation of the ATM. Presumably this includes the controls associated with the ATM. The user would perform various functions, as if the simulation were the ATM, and then would be given nothing. This correlates in effect to the "demonstration" of the ATM. In a more technical analysis. The ATM of applicant's invention is driven by software components that cause it to display certain options, make certain calculations and produce a result (i.e. a printed receipt, cash from a withdrawal, and such). The simulation of the applicant's ATM is based upon the same generic code, that being the code that controls how the system responds. The only difference being nothing is actually done when the simulation is complete, the user hasn't made a withdrawal, a balance inquiry, or any other transaction that affects their real-life account. This is consistent with the game of Adams. The user is using a version of the software in which they are not rewarded with anything has a value outside the game context. Thus for the embodiment of at least the casino game the user of the demonstration is experiencing a simulation of the actual casino game. The examiner further notes that the general statement has been made that the use of general advertisement cannot be equated to the step of providing the address of the simulator. Applicant however, has failed to show how this equation is improper or provide any support for the assertion.

In paragraph 16 of the response applicant argues that the examiner has failed to show why one of ordinary skill in the art would have selected to modify the reference with both a simulator and the hard copy reference of to the simulator. The simulator has been addressed above. Regarding the motivation for the addition of the removable media such as the business card. The examiner has provided a clear motivation in the above rejection of the claims. Specifically the examiner has stated that it would have been obvious to include the removable

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documents so that a user could easily recall the information at a later time. This purpose is a common use for documents such as business cards, pamphlets, etc. Applicant has not made any arguments directed specifically to this motivation. Nor has applicant shown any evidence to challenge this specific motivation.

Lastly applicant asserts that the examiner's position that the specific components selected for the simulation is a matter of design choice is flawed. In view of the above comments, the examiner maintains this position. When the user is simulating a casino game, such as a slot machine, it is not required that each peripheral device be fully simulated. The creator of the simulation may choose to simulate the "token" dispenser of a common slot machine so as to make the overall simulation more realistic. Similarly, if the game is significantly complex this feature may be omitted so as to not overly confuse the user. In the embodiment of the applicant's internet access terminal, the user may choose to incorporate a screen display of a keyboard associated with the terminal if there is sufficient reason to believe a user may need practice with such. However, if the keyboard operations of the terminal are substantially similar to standard keyboard operations the designer of the simulation may choose to omit it so as to not make the simulation over complex. Further the applicant has failed to show any specific advantage or unexpected result associated with the visual simulation of other peripherals.

The examiner notes that the applicant has failed to challenge the takings of official notice in the previous office action. As such the following teachings are now considered to be admitted prior art:

That is old and well-known to include a web address in an advertisement

That business cards being a removable advertisement is old and well-known (confirmed by applicant in paragraph 16 of the response)

See MPEP 2144.03.

Conclusion

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

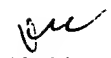
Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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